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Introduction

The explosion in media technology makes many of today's celebrities immediately recognizable. This allows them, if they choose, to capitalize on their identifiability beyond their artistic mediums through advertisements and endorsements.[1] Whether or not a celebrity does so, the celebrity has an understandable interest in barring others from profiting from the recognition value he has created.[2]

The law has not always protected the exclusive right of a celebrity to control the commercial exploitation of his personality and talents.[3] Today, however, society views celebrity as a "commodity" or "property."[4] As a result of this evolution, many states now recognize a celebrity's "right of publicity" by common law, statute, or both.[5]

Even when recognized, however, the content of the right of publicity often remains uncertain and its limits unclear.[6] This is particularly true in California for several reasons. First, development of the right of publicity in California has been "spasmodic,"[7] springing from, and remaining intertwined with, the California common law right of

1. As former Chief Justice Bird of the California Supreme Court observed:

> Today, it is commonplace for individuals to promote or advertise . . . products or . . . even have their identities infused in the products. Individuals prominent in athletics, business, entertainment and the arts, for example, are frequently involved in such enterprises. . . . As a result, the sale of one's persona in connection with the promotion of commercial products has unquestionably become big business. . . .
>
> Such commercial use of an individual's identity is intended to increase the value or sales of the product by fusing the celebrity's identity with the product and thereby siphoning some of the publicity value or good will in the celebrity's persona into the product. This use is premised, in part, on public recognition and association with that person's name or likeness, or an ability to create such recognition.

Lugosi v. Universal Pictures, 603 P.2d 425, 437-38 (Cal. 1979) (Bird, C.J., dissenting) (citations omitted).

2. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 210-11 (1954). *Cf. Lugosi*, 603 P.2d at 439 n.11 (Bird, C.J., dissenting) (unauthorized use also infringes on the celebrity's efforts "to control the public projection of . . . identity, including the desire for solitude and anonymity").

3. *See* Nimmer, *supra* note 2, at 204.

4. George M. Armstrong, Jr., *The Reification of Celebrity: Persona as Property*, 51 LA. L. REV. 443, 444 (1991).

5. The right of publicity is "the right of each person to control and profit from the publicity values which he has created or purchased." Nimmer, *supra* note 2, at 216.

6. Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1590 (1979).

7. Lugosi v. Universal Pictures, 603 P.2d 425, 439 n.14 (Cal. 1979) (Bird, C.J., dissenting) ("spasmodic" development attributable to treatment of right of publicity claims as right of privacy claims).

privacy.[8] Second, California legislation has been piecemeal,[9] driven by the courts' failure to provide remedies for specific instances of commercial exploitation.[10] Under the resulting statutory scheme, living celebrities and non-celebrities enjoy the same personal rights,[11] but only celebrities enjoy descendible property rights in the attributes of their personalities.[12]

Finally, the California Supreme Court has never faced a novel infringement of celebrity publicity rights. In fact, California appellate courts have yet to consider a complaint for the unauthorized use of anything other than a celebrity's name, photograph, or likeness.[13] Plaintiffs have filed the bulk of recent actions to which California law applies in federal courts on the basis of diversity jurisdiction.[14] As a result, federal courts have been left to determine state law.

Two recent Ninth Circuit cases in which the California right of publicity was at issue took a broad view of the common law right, while interpreting the statutory right narrowly. In *Waits v. Frito-Lay, Inc.*,[15] the court upheld an award of damages against Frito-Lay for appropriating, by impersonation, singer Tom Waits's voice.[16] In *White v. Samsung Electronics America, Inc.*,[17] the court preserved entertainer Vanna White's common law claim against Samsung for using a "Vanna White" robot in its ads. At the same time, it affirmed the district court's dismissal of White's statutory cause of action.[18]

8. *See, e.g.*, Eastwood v. Superior Ct., 198 Cal. Rptr. 342 (Ct. App. 1983) (applying privacy precedents in adjudicating right of publicity claim).

9. Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1223 (1986) ("California's piecemeal attack . . . will make it . . . more difficult for the courts . . . effectively to articulate the values and interests around which this area of the law must function and thus will generate the 'bad law' that inevitably flows from 'hard cases.'").

10. *See infra* notes 59, 80.

11. CAL. CIV. CODE § 3344 (West Supp. 1993).

12. *Id.* § 990.

13. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1402 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993) (Alarcon, J., dissenting).

14. This is true of all claims for appropriation of actual voice or imitation of voice in which California law has been applied. *See* Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992); Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); Motown Record Corp. v. George A. Hormel & Co., 657 F. Supp. 1236 (C.D. Cal. 1987); Davis v. Trans World Airlines, 297 F. Supp. 1145 (C.D. Cal. 1969).

15. 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993). Waits asserted a common law right of publicity claim. *See infra* text accompanying notes 128-52.

16. *Id.* at 1112.

17. 971 F.2d at 1399. *See infra* text accompanying notes 153-88.

18. *Id.* at 1397.

Two assumptions about California common law guided these federal court decisions. The first assumption is that California courts recognize a right of publicity that encompasses a celebrity's "identity,"[19] unlike the California statute, which is expressly limited to commercial appropriation of specific attributes. The second assumption is that California courts recognize this interest in "identity" as a property right, rather than a personal right.[20] Neither assumption, however, is supported by California state court decisions.

This Note discusses this divergence in "California" law. Part I describes the evolution of the right of publicity. Part II summarizes the California statutory rights and the status of California common law based on California appellate court cases. Part III illustrates the Ninth Circuit's view of the California common law right of publicity as synthesized in *Waits* and *White*. Part IV measures *Waits* and *White* against the historical background of the right of publicity, California precedents, and policy considerations (suggesting that California courts would sustain Waits's claim, but would dismiss White's). Part V urges legislative action to discourage forum shopping by clearly defining the substance of the California right of publicity.

I
Evolution of the Right of Publicity

The right of publicity grew out of and often remains linked with the right of privacy. One American decision noted a right of privacy as early as 1867.[21] Samuel Warren and Louis Brandeis, however, are traditionally credited[22] as the first to argue for the recognition of invasion of privacy as a cause of action in tort in their landmark 1890 law review article, *The Right of Privacy*.[23]

Their underlying premise was that everyone has a property interest in the expressions of his own personality.[24] They argued that courts should extend this premise, which underscores copyright and

19. *Id.* at 1398-99.

20. *Waits*, 978 F.2d at 1100. Property classification implies that the right is alienable and inheritable. Armstrong, *supra* note 4, at 444.

21. Gringsby v. Breckenridge, 65 Ky. (2 Bush) 480 (1867). The significant issue in the case was whether the author or the recipient of certain letters had a general property interest in the letters. See Basil W. Kacedan, Note, *The Right of Privacy*, 12 B.U. L. REV. 353, 364-65 (1932), for a discussion of the case.

22. Leon R. Yankwich, *The Right of Privacy: Its Development, Scope and Limitations*, 27 NOTRE DAME LAW. 499, 501 (1952).

23. Samuel D. Warren & Louis D. Brandeis, *The Right of Privacy*, 4 HARV. L. REV. 193 (1890).

24. *See id.* at 198-202.

patent law, to protect a person's privacy from invasion by the "too enterprising press" or any "modern device for recording or reproducing sound."[25] What was at risk to "modern enterprise and invention" was the individual's mental composure.[26] Therefore, while Warren and Brandeis grounded their theory on personality as "property," they argued for recognition of the right of privacy as a personal right—a right "to be let alone."[27] The essence of the harm was the injury to feelings.[28]

Seventy years later, Dean William Prosser synthesized over 400 right of privacy cases that had already been decided.[29] Recognizing that invasions of privacy interfered with different forms of the right "to be let alone," he separated them into four separate torts.[30] The fourth tort, according to Prosser, involved "exploitation of attributes of the plaintiff's identity" and consisted of the appropriation of a person's name or likeness for another's advantage.[31]

Although he used name and likeness in defining "appropriation," Prosser's actual concern was with identifiability. Appropriation had to be more than the unauthorized use of a person's name to be actionable; it had to involve the use of the name "as a symbol of [the plaintiff's] identity."[32] At the same time, Prosser suggested appropriation

25. *Id.* at 205-06. "[T]he legal doctrines relating to infractions of what is ordinarily termed the common-law right to intellectual and artistic property . . . are applications of a general right to privacy." *Id.* at 198.

26. *Id.* at 196. In this respect the protected interest was unlike that protected by copyright because the value was not in the right to take profits. *Id.* at 200. *See also* Roscoe Pound, *Interests in Personality*, 28 HARV. L. REV. 343, 363-64 (1915) ("A man's feelings are as much a part of his personality as his limbs."). Feelings were part of the right to physical integrity, one of the seven components of personality discussed by Pound. *Id.* at 355-56. Among the other rights of personality Pound enumerated were the rights of property and free industry. *Id.* at 353-54.

27. Warren & Brandeis, *supra* note 23, at 195. As a term of art, the right "to be let alone" is attributed to Judge Cooley. THOMAS M. COOLEY, A TREATISE ON THE LAW OF TORTS 29 (1879).

28. Warren & Brandeis, *supra* note 23, at 213, 219. The gist of a cause of action for invasion of privacy is "a direct wrong of a personal character resulting in injury to the feelings without regard to any effect which the publication may have on the property, business, pecuniary interest, or the standing of the individual in the community." Fairfield v. American Photocopy Equip. Co., 291 P.2d 194, 197 (Cal. Dist. Ct. App. 1955).

29. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

30. *Id.* at 389. The four distinct torts were recognized by the California Supreme Court in Kapellas v. Kofman, 459 P.2d 912, 921 n.16 (Cal. 1969) (en banc).

31. Prosser, *supra* note 29, at 401. The other three torts are (1) intrusion upon another's seclusion or solitude, or into his private affairs; (2) public disclosure of embarrassing private facts about another; and (3) publicity which places another in a false light in the public eye. *Id.* at 389. Right of privacy actions often involve more than one of Prosser's torts. *See, e.g.*, *Fairfield*, 291 P.2d 194.

32. Prosser, *supra* note 29, at 403-04. According to Prosser:

of identity could occur without using either a person's name or likeness, "as by impersonation."[33]

Prosser recognized that an individual's interest in the "aspect[s] of his identity" was more proprietary in nature than the mental interest protected by his other three privacy torts.[34] However, he found it "pointless to dispute" whether the right was "property."[35] "If it is not, it is at least, once it is protected by the law, a right of value upon which the plaintiff can capitalize by selling licenses."[36] "Appropriation," as framed by Prosser, therefore encompassed both a personal (mental) interest and a proprietary (commercial) interest.[37]

When someone uses the identity of a celebrity, however, the commercial interest largely displaces the mental interest.[38] A celebrity, unlike a non-public figure, neither wishes to remain anonymous nor experiences hurt feelings from publicity in general.[39] Compared to the private individual, whose mental interest is served by suppressing publication, often the only question with the celebrity is "*who* gets to do the publishing."[40] As a result, an unauthorized use of identity may inflict solely economic harm.[41]

Courts that understood privacy only in the sense of a personal right "to be let alone" had difficulty recognizing this commercial inter-

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> It is when [the defendant] makes use of the name to pirate the plaintiff's identity for some advantage of his own . . . that he becomes liable.
>
> On this basis, the question before the courts has been whether there has been appropriation of an aspect of the plaintiff's identity. It is not enough that a name which is the same as his is used . . . unless the context or the circumstances, or the addition of some other element indicate that the name is that of the plaintiff.

Id. (footnotes omitted).

33. *Id.* at 401 n.155.

34. *Id.* at 406.

35. *Id.*

36. *Id.*

37. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5.8[A] (1988). Prosser's combination of the interests has often been criticized as a source of confusion in the law. *E.g.*, Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 834 (6th Cir. 1983).

38. Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824 (9th Cir. 1974).

39. As Melville Nimmer noted:

> Well known personalities . . . do not seek the "solitude and privacy" which Brandeis and Warren sought to protect. Indeed, privacy is the only thing they do "not want or need." Their concern is rather with publicity, which may be regarded as the reverse side of the coin of privacy. However, although the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him.

Nimmer, *supra* note 2, at 203-04 (footnotes omitted). *See also infra* note 46.

40. Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 573 (1977) (emphasis added).

41. *See id.* at 573; *Carson*, 698 F.2d at 835; *Motschenbacher*, 498 F.2d at 824.

est.[42] They struggled to apply traditional privacy theory when well-known persons sued for unauthorized use of their names or likenesses.[43] As a result, courts often denied recovery, reasoning that those who voluntarily chose public exposure could not claim mental distress.[44]

The Second Circuit was the first to separate the commercial interest in appropriation from the mental interest. In *Haelan Laboratories v. Topps Chewing Gum*,[45] Judge Jerome Frank called this independent right to control and profit from celebrity the "right of publicity."[46]

Like Prosser, Judge Frank found it "immaterial" whether the right was "labeled a 'property' right."[47] Commentators who championed the *Haelan* decision and urged widespread recognition of the right of publicity, however, regarded its classification as property to be essential.[48] They reasoned that if the right of publicity were a personal right, like privacy, it would not be assignable.[49] Any licensee of a celebrity's name or likeness therefore could not enforce the license, reducing its commercial value.[50] Commentators also argued that the right of publicity would expire at death if not classified as property, leaving a celebrity's heirs powerless to prevent exploitation of the deceased.[51]

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42. MCCARTHY, *supra* note 37, at § 1.6.

43. *Id.*

44. *Id.*

45. 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

46. *Id.* at 868. In *Haelan*, a baseball player gave two competing bubble gum companies "exclusive" agreements to use his photograph. When the first sued the second to enforce its exclusive rights, the defendant argued that the contracts represented only releases of the liability each would have incurred to the baseball player for invasion of privacy had they otherwise used his photograph. Since the right of privacy is a personal right, the defendant contended the contract was not effective as an assignment and the plaintiff had no standing to sue. The court rejected these arguments, holding that the baseball player had assigned a right distinguishable from the right of privacy. The court reasoned:

> We think that, in addition to and independent of [the] right of privacy . . . a man has a right . . . to grant the exclusive privilege of publishing his picture . . . . This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements. . . . This right of publicity would usually yield . . . no money unless it could be made the subject of an exclusive grant. . . .

Id.

47. *Id. See supra* text accompanying notes 35-36.

48. Nimmer, *supra* note 2, at 216.

49. *Id.*

50. *See id. See also supra* note 46; *infra* note 79.

51. *See generally* Harold R. Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553, 599-605 (1960) (describing the issues involved with descendibility).

The right of publicity is a creature of state law and each state defines the right differently.[52] States have recognized it either (1) by common law only; (2) by statute that codifies and supplants the common law; or (3) by statute that supplements common law, as in California.[53] Some states have accepted commentators' arguments and recognize an independent property right, whether or not they actually call it a right of publicity.[54] In other states, the right remains a personal right bundled with the right of privacy.[55] The California right, while based on Prosser's tort of appropriation, is a patchwork of both approaches.

II
California Rights as Defined by California Courts and the California Legislature

California courts recognized the common law right of privacy in 1931[56] and the common law right of publicity in 1979.[57] In 1971, the

52. Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 578-79 (1977). Two principal considerations limit the extent of the right of publicity. The most important countervailing influence is the First Amendment. Armstrong, *supra* note 4, at 467. Because this Note focuses on potentially deceptive advertising, which enjoys little or no First Amendment protection, potential First Amendment issues are not discussed. However, the Supreme Court, in its one and only right of publicity case, specifically noted that the case did not "merely assert that some general use, such as advertising, was made of [the plaintiff's] name or likeness," in holding that the First Amendment did not bar the plaintiff's claim. *Zacchini*, 433 U.S. at 573 n.10.

The other factor limiting the expansiveness of the right of publicity is the rights of others who contribute to the performance. Armstrong, *supra* note 4, at 467. Copyright law often, but not always, protects the interests of third persons. *Id.*; *see, e.g.*, Motown Record Corp. v. George A. Hormel & Co., 657 F. Supp. 1236, 1240-41 (C.D. Cal. 1987) (right of publicity preempted by Copyright Act in action based on advertisement in which singing style and appearance of The Supremes was imitated).

53. Leonard A. Wohl, Note, *The Right of Publicity and Vocal Larceny: Sounding Off on Sound-Alikes*, 57 FORDHAM L. REV. 445, 450-51 n.53 (1988).

54. *Compare* KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984) (recognizing right of publicity as property right) *with* TENN. CODE ANN. § 47-25-1103 (1984) (recognizing property right in use of name, photograph, and likeness without referring to right of publicity).

55. *See, e.g.*, VA. CODE ANN. § 8.01-40 (Michie 1984).

56. Melvin v. Reid, 297 P. 91 (Cal. Dist. Ct. App. 1931). While the case was later pointed to as the seminal California right of privacy decision, the *Melvin* court avoided use of the term in its holding. The court also did not tie its decision to the precepts espoused by Warren and Brandeis, but tied it instead to the inalienable right guaranteed by the California Constitution "to pursue and obtain happiness." *Id.* at 93. The court said: "The right of privacy as recognized in a number of states has been defined as . . . 'the right to live one's life in seclusion, without being subjected to unwarranted and undesired publicity. In short, it is the right to be let alone.'" *Id.* at 92 (citations omitted). However, the court was "loath to conclude that the right of privacy as the foundation for an action in tort, in the form known and recognized in other jurisdictions, exist[ed] in California." *Id.* at 93.

legislature "complemented" common law[58] by creating a statutory cause of action for specific forms of commercial appropriation.[59] The legislature amended the statute in 1984, adding a separate action that the heirs or assignees of deceased celebrities could assert.[60]

"Whether we call this a right of privacy or give it any other name is immaterial, because it is a right guaranteed by our Constitution that must not be ruthlessly and needlessly invaded by others." *Id.* at 93-94. Over 40 years later, in November 1974, the California Constitution was amended to include "pursuing and obtaining . . . privacy" as an inalienable right. CAL. CONST. art. I, § 1.

Despite its variant underpinnings, *Melvin*, like Warren and Brandeis, focused on the right to be let alone and the mental interest affected by the intrusion or appropriation. *Melvin*, 297 P. at 93. The right of privacy was not recognized by the California Supreme Court until 1952, in Gill v. Curtis Publishing Co., 239 P.2d 630 (Cal. 1952).

Later courts, influenced by Prosser, increasingly noted both the mental and commercial interests in appropriation. *See, e.g.*, Williams v. Weisser, 78 Cal. Rptr. 542 (Ct. App. 1969) (university professor's damage award based on commercial value of lecture notes published under his name without consent); Stilson v. Reader's Digest Ass'n, Inc., 104 Cal. Rptr. 581 (Ct. App. 1972) (plaintiffs have right to show financial detriment, as well as mental anguish, for commercial exploitation of name).

57. Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (en banc). As the *Melvin* court before it did with the "right of privacy," the *Lugosi* majority eschewed use of the term "right of publicity" in its holding. However, shortly thereafter, in Guglielmi v. Spelling-Goldberg Productions, 603 P.2d 454, 455 (Cal. 1979) (en banc), the California Supreme Court said: "In *Lugosi*, we hold that the right of publicity protects against the unauthorized use of one's name, likeness or personality. . . ."

58. *Lugosi*, 603 P.2d at 428 n.6.

59. Act of Nov. 22, 1971, ch. 1595, 1971 Cal. Stat. (codified as amended at CAL. CIV. CODE § 3344). Although New York, in particular, had enacted right-to-privacy legislation as early as 1903, California's original efforts were unsuccessful. A 1939 bill (A.B. 2004), patterned after the New York privacy statute, passed unanimously in both California houses, but was vetoed by the governor. Robert B. Miller, Note, *Commercial Appropriation of An Individual's Name, Photograph or Likeness: A New Remedy for Californians*, 3 PAC. L.J. 651, 652 n.3 (1972). The legislature did not resurrect the effort until 1971.

"The purpose of the [1971] bill, A.B. 826, was to crack down on sales schemes in which a manufacturer or retailer randomly selected a person's name and used it to promote a particular product." REPORT OF SENATE COMM. ON JUDICIARY, 1983-84 Reg. Sess., S.B. 613, as amended May 9, 1984 (unpublished report, copy on file with Assembly Republican Caucus Library). The legislative history "characterized the problem presented as an 'invasion of privacy.' . . . [T]here is no mention in the legislative documents of the right of publicity or the economic interest protected thereunder." *Lugosi*, 603 P.2d at 443 n.23 (Bird, C.J., dissenting).

60. Act of Sept. 30, 1984, ch. 1704, 1984 Cal. Stat. (codified as amended at CAL. CIV. CODE §§ 990, 3344). Although nothing in the 1971 legislative history mentions the right of publicity, at least one commentator at the time of § 3344's adoption hypothesized that the legislation might create a right of publicity for the personal identities of celebrities and non-celebrities alike. Miller, *supra* note 59, at 662-63. By the time § 3344 was amended, this view was shared by the legislature: "The California legislature enacted Civil Code section 3344 in 1971, codifying a portion of the right of publicity and according statutory recognition to the previous common law evolution of that right." Memorandum to the California Assembly Judiciary Comm. (Feb. 14, 1984) (unpublished memorandum, copy on file with Assembly Republican Caucus Library). According to the amendment's author, the 1971 legislation "recognize[d] the right of living celebrities to protect against the unauthorized use of their . . . name [sic] without permission. . . . Senate Bill 613 will take

A. Statutes

1. *Civil Code Section 3344*

Civil Code section 3344 protects both celebrities and non-celebrities from unauthorized commercial appropriation, although it does not refer to the rights it creates as either rights of publicity or rights of privacy.[61] The statute, however, implicitly emphasizes the proprietary interest in being free from commercial exploitation over the mental interest in being "let alone."[62]

Initially, section 3344 exclusively protected against unauthorized[63] use of name, photograph,[64] and likeness.[65] In 1984, the legislature added voice and signature.[66]

Section 3344 only protects against appropriation of these specified attributes to advertise or to sell goods or services,[67] although use

existing rights of publicity enjoyed by living celebrities under current law and extend these rights to their heirs for a period of 50 years beyond the death of the celebrity." Transmittal letter from Senator William Campbell to Governor George Deukmejian (Aug. 31, 1984) (on file with author).

61. *See* Stephen F. Rohde, *Dracula: Still Undead*, CAL. LAW., Apr. 1985, at 53.

62. The effect of this is that a non-celebrity, whose right to control the attributes of his personality stems from his right "to be let alone," may sue under California law to recover the economic benefits when another uses an attribute, such as his photograph, for that person's advantage. James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 652 (1973). At the same time, the celebrity, whose principal interest may be in his commercial value, does not lose his "privacy" interest as the statute is structured. He may assert injury to his feelings when the unauthorized use has this effect. *Id.*

63. Consent, as under common law, may be written or oral and may result from a course of conduct. Jerome E. Weinstein, *Commercial Appropriation of Name or Likeness: Section 3344 and the Common Law*, L.A. BAR J., Mar. 1977, at 440. Section 3344 also provides for a minor's consent by his parent or legal guardian. § 3344(a).

64. A "photograph" is "any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person such that the person is readily identifiable." § 3344(b). "A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use." § 3344(b)(1).

65. No case has directly construed the meaning of the word "likeness" under § 3344. Nurmi v. Peterson, 10 U.S.P.Q.2d 1775, 1777 (C.D. Cal. 1989). California right of privacy and publicity actions "have implied that the term 'likeness' means an actual representation of a person, rather than a close resemblance." *Id.*; *see infra* notes 95, 98.

66. Act of Sept. 30, 1984, ch. 1704, 1984 Cal. Stat. (codified at CAL. CIV. CODE § 3344(a)). "Voice" and "signature" were treated as "technical amendments," designed to clarify "the intended purview of the right." REPORT OF SENATE COMM. ON JUDICIARY, *supra* note 59, at 5. Earlier versions of the amendment extended coverage to a person's "image," but the legislature removed this from the final version. A Senate report suggested: "SHOULD NOT IMAGE BE DEFINED?" *Id.* at 4.

67. Consent is specifically not required to use a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign. § 3344(d).

for advertising or sale of goods or services alone is not enough to make an appropriation actionable.[68] There must be a "direct connection" between the use of the attribute and the commercial purpose.[69] The use also must be knowing[70]—inadvertence or mistake is a complete defense.[71] The use, however, need not imply an endorsement to be actionable.

Section 3344 provides for statutory damages equal to the greater of $750 or actual damages.[72] A successful plaintiff also can recover any profits made by the infringer from the unauthorized use not included in the actual damages.[73] As a result, a court can award damages measured by *both* the harm to the plaintiff and the profits to the defendant.[74] In addition, section 3344 provides for the award of punitive damages and entitles the prevailing party to attorney's fees.[75] These remedies are cumulative and in addition to others allowed by law.[76]

The rights that section 3344 creates are personal, not property, rights.[77] As such, these rights do not appear to be assignable;[78] there-

68. § 3344(e).

69. It is a question of fact whether the use is so directly connected with the commercial sponsorship or with the paid advertising as to require consent. § 3344(e). If the use is not substantially related to the pecuniary motive, or the particular use neither advances nor is intended to advance that motive, there is no liability. Weinstein, *supra* note 63, at 440; *see also* Johnson v. Harcourt, Brace, Jovanovich, Inc., 118 Cal. Rptr. 370, 381 (Ct. App. 1974).

70. The "knowing" requirement may flow from the penal damages provision in an early version of the 1971 legislation. Its retention may be attributable to the minimum damages provision. Miller, *supra* note 59, at 660.

71. Weinstein, *supra* note 63, at 433-34.

72. The author of the bill believed that a "minimum amount recoverable would ensure that the average citizen, who cannot show that his name, photograph, or likeness has a commercial value to the public, would recover more than nominal damages, which . . . are damages in name only and are the same as no damages at all." Miller, *supra* note 59, at 661 (citing Fairfield v. American Photocopy Equip. Co., 291 P.2d 194, 197 (Cal. Dist. Ct. App. 1955)).

73. "In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses." § 3344(a).

74. Eastwood v. Superior Court, 198 Cal. Rptr. 342, 352 n.10 (Ct. App. 1983).

75. § 3344(a).

76. § 3344(g).

77. *See* Weinstein, *supra* note 63, at 435; *see also infra* note 117.

78. *But see infra* notes 80-90 and accompanying text. Section 990, the companion statute to § 3344 expressly characterizes the rights it creates on behalf of deceased celebrities as "property rights, freely transferable." No similar provision appears in § 3344; in fact, the legislature deleted a comparable provision from the 1984 amendment to § 3344. Commentators suggest that "a strong argument can be made that a living personality cannot assign or transfer the rights recognized under section 3344 during his lifetime." Rohde, *supra* note 61, at 53; *accord* Halpern, *supra* note 9, at 1223 n.134.

fore, a third party licensee of a protected attribute lacks standing to sue.[79] Further, except as described below, the rights expire at death.

2. Civil Code Section 990

A separate section of the Civil Code, section 990,[80] creates civil liability for the unauthorized use of the attributes of a "deceased personality."[81] It protects the name, photograph, voice, signature, and likeness of such individuals against the same types of appropriations found in section 3344.[82] The damages available in an action under section 990 are also the same as those allowed under section 3344.[83]

79. Nimmer described the consequences of non-assignability as follows:

> [A]ny agreement purporting to grant the right to use the grantor's name and portrait (as in connection with a commercial endorsement or tie-up) is construed as constituting merely a release as to the purchaser and as not granting the purchaser any right which he can enforce as against a third party. Thus, if a prominent motion picture actress should grant to a bathing suit manufacturer the right to use her name and portrait in connection with its product and if subsequently a competitive manufacturer should use the same actress's name and portrait in connection with its product, the first manufacturer cannot claim any right of action . . . against its competitor since the first manufacturer cannot claim to "own" the actress's right [of publicity]. Assuming the second manufacturer acted with the consent of the actress, it is possible that the first manufacturer would have a cause of action for breach of contract against the actress, but this would present a remedy in damages only and in some instances even recovery of damages might be doubtful. Therefore, if a prominent person is found merely to have a personal right . . . and not a property right . . . the important publicity values which he has developed are greatly circumscribed and thereby reduced in value.

Nimmer, *supra* note 2, at 209-10 (citation omitted). *But see supra* note 46.

80. After the *Lugosi* decision, *see infra* notes 115-23 and accompanying text, which held that a celebrity's right of publicity did not descend to his heirs, California State Senator William Campbell proposed a one paragraph amendment to § 3344 to nullify the decision by extending § 3344's existing protection for 50 years after a person's death and to vest the ability to maintain a cause of action in the person's heirs. S.B. 613, 1983-84 Reg. Sess. (1983). The legislation, which became known as the "dead celebrity bill," was prompted by the Screen Actors Guild and supported by celebrities and heirs of deceased celebrities. Rohde, *supra* note 61, at 53. The original amendment did not, however, distinguish between celebrities and non-celebrities. The Senate amended S.B. 613 twice; the Assembly amended it six times. What was eventually enacted was a bifurcated statute that made the additions to § 3344 described above, increased the available damages, and added § 990. The legislative history indicates that the modifications and resulting bifurcation of S.B. 613 were done so that § 990 would expressly categorize the rights as property rights, distinguishing the right of publicity from the privacy rights protected by § 3344. *But see supra* text accompanying note 61.

81. § 990(a). "'Deceased personality' means any natural person whose name, voice, signature, photograph, or likeness has commercial value at the time of his or her death, whether or not during the lifetime of that natural person the person used his or her name, voice, signature, photograph, or likeness on or in products, merchandise or goods, or for purposes of advertising or selling, or solicitation of purchase of, products, merchandise, goods or service." § 990(h).

82. § 990(a).

83. *Id.*

However, section 990 differs from section 3344 in that it specifically designates the rights it creates as property rights.[84] It makes these rights freely transferable by contract, trust, or testamentary document,[85] whether or not the deceased personality commercially exploited one or more of the covered attributes while alive.[86] Specified intestate successors may exercise the deceased personality's rights if they are not otherwise transferred.[87] Similar to copyright, the rights expire fifty years after the personality's death.[88]

The use of the deceased personality's attributes, unlike section 3344, need not be knowing to be actionable under section 990. To recover damages, however, any licensee or successor to the rights must have registered a claim with the California Secretary of State describing the rights claimed[89] before the unauthorized use.[90]

B. Common Law

While any Californian can sue under section 3344, only those individuals whose public recognition makes them "commercially exploitable" can claim infringement of their common law right of publicity.[91] A celebrity's publicity rights under California common law, however, differ little from a non-celebrity's privacy rights, since California courts continue to rely on privacy precedents in publicity cases.[92] Both are grounded in Prosser's tort of appropriation.[93]

In accord with appropriation cases under the privacy umbrella, courts have held that the common law right of publicity protects a celebrity during life from the nonconsensual use[94] of his name, photo-

84. § 990(b). The second Assembly amendment of S.B. 613 categorized all the rights as property rights. When the legislature split the changes into two sections, however, the recognition of a property right was retained only in § 990. *See supra* notes 78, 80.

85. § 990(b).

86. § 990(h).

87. § 990(d).

88. § 990(g).

89. § 990(f)(2).

90. § 990(f)(1)-(2).

91. Lugosi v. Universal Pictures, 603 P.2d 425, 431 (Cal. 1979) (en banc).

92. *See, e.g.*, Eastwood v. Superior Court, 198 Cal. Rptr. 342 (Cal. App. 1983). *See also Lugosi*, 603 P.2d at 431 ("The protection of name and likeness from unwarranted intrusion or exploitation is the heart of the law of privacy.").

93. *See Lugosi*, 603 P.2d at 428-29.

94. Privacy precedents suggest consent can be either written or oral. Weinstein, *supra* note 63, at 440. A court following privacy precedents also could find waiver or relinquishment of the right, or of some aspect thereof, from the conduct of the parties or the circumstances. *Id.* (citing Metter v. Los Angeles Examiner, 95 P.2d 491, 496 (Cal. Dist. Ct. App. 1939)).

graph, or likeness.[95] *Eastwood v. Superior Court* also indicates courts will extend protection to voice and signature,[96] although no California appellate court has reported a decision involving the unauthorized use of either.[97]

Further, common law protection may not be limited to these particular attributes. In *Lugosi v. Universal Pictures*, the California Supreme Court held that the common law right of publicity protects a celebrity's "personality."[98] Since Universal used Lugosi's likeness, however, this holding is not considered authority for creating an actionable right of publicity outside that context.[99] The concurring justices in *Guglielmi v. Spelling-Goldberg Productions, Inc.*, decided immediately after *Lugosi*, specifically reserved determining whether the right of publicity would attach to a celebrity's "personality," due to the difficulty in discerning "any easily applied definition for this amorphous term."[100] Although courts of appeal have suggested otherwise, the *Lugosi* holding and accompanying dicta suggest that common law may protect celebrities to a greater extent than the statute.[101]

95. *See, e.g., Lugosi*, 603 P.2d at 431; *Eastwood*, 198 Cal. Rptr. at 347. "Likeness" appears to refer to a fairly exact copy of another's features. For example, a dracula character that unmistakably bore the plaintiff's features could constitute sufficient appropriation to be the subject of a right of publicity action, while a generic dracula, which might resemble the plaintiff in many ways, would not. *See Lugosi*, 603 P.2d at 427-28

96. *Eastwood*, 198 Cal. Rptr. at 346 n.6.

97. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1402 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993) (Alarcon, J., dissenting).

98. At least this is how the California Supreme Court characterized the *Lugosi* decision in *Guglielmi*, decided immediately after *Lugosi*. Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 455 (Cal. 1979) (en banc); *accord* Fairfield v. American Photocopy Equip. Co., 291 P.2d 194, 197 (Cal. Dist. Ct. App. 1955) ("[T]he exploitation of another's personality for commercial purposes constitutes one of the most flagrant and common means of invasion of privacy.").

Lugosi also has been interpreted as establishing that an actor has a strong claim to the exclusive use of a fictional role he has created. KBG, Inc. v. Giannoulas, 164 Cal. Rptr. 571, 580 (Ct. App. 1980). However, a strong showing is necessary to restrict an allegedly infringing performance where rights to a stage character are at issue. *Id.* at 581.

99. Weinstein, *supra* note 63, at 438.

100. *Guglielmi*, 603 P.2d at 457 n.5.

101. *Compare* Eastwood v. Superior Court, 198 Cal. Rptr. 342, 347 (Ct. App. 1983) ("The differences between the common law and statutory actions [for commercial appropriation] are: (1) Section 3344, subdivision (a) requires a knowing use whereas under case law, mistake and inadvertence are not a defense against commercial appropriation; and (2) Section 3344, subdivision (g) expressly provides that its remedies are cumulative and in addition to any provided by law.") (citations omitted) *with* Lugosi v. Universal Pictures, 603 P.2d 425, 428 n.6 (Cal. 1979) (en banc) (noting that Prosser's appropriation "has been *complemented legislatively* by Civil Code section 3344, adopted in 1971") (emphasis added).

In addition, common law may prohibit more forms of unauthorized use than section 3344 prohibits.[102] Prior cases, unlike section 3344, do not limit actionable appropriations to those in which the unauthorized use is for advertising or sale of goods and services.[103] The *Guglielmi* opinion, in fact, suggests *any* unauthorized use would infringe the common law right of publicity.[104] The concurring opinion in *Guglielmi* and dicta in other cases, however, envision a significantly more circumscribed right, considering appropriation actionable only if done for commercial purposes.[105]

Another distinction is that California common law, unlike section 3344, imposes strict liability on a defendant.[106] Inadvertence and mistake are not defenses.[107] *Kerby v. Hal Roach Studios, Inc.*, an early invasion of privacy case based on an alleged name appropriation, suggests that a defendant's intent to refer to someone other than the plaintiff may not preclude liability.[108] In *Kerby*, the court held that an appropriation would be actionable if someone could reasonably construe the appropriated attribute as belonging to the plaintiff.[109]

California common law also may differ from section 3344 in the availability and calculation of damages. It is unclear under common law whether a plaintiff can recover damages based on both the harm

102. The *Eastwood* court, in dictum, noted that privacy precedents do not constrain the types of commercial exploitations that may be actionable under either the privacy or publicity rubric. 198 Cal. Rptr. at 347. The significant countervailing consideration is the First Amendment. *See supra* note 52.

103. *See, e.g., Eastwood*, 198 Cal. Rptr. at 347 ("A common law cause of action for appropriation . . . may be pleaded by alleging . . . appropriation . . . to defendant's advantage, commercially or *otherwise*.") (emphasis added). Also, as under § 3344, the unauthorized use need not suggest the celebrity's endorsement to be actionable. Maheu v. CBS, 247 Cal. Rptr. 304, 312 (Ct. App. 1988).

104. *Guglielmi*, 603 P.2d at 455.

105. *See id.* at 457 (Bird, C.J., concurring) (complaint states common law cause of action if: (1) plaintiff has "a right of publicity in the *commercial* uses of his name . . . and (2) [defendant's] conduct constituted an impermissible infringement on that right ") (emphasis added). Similar to § 3344, common law appears to require some connection between the use of the attribute and the commercial purpose. *Id.* at 461 (Bird, C.J., concurring) (unauthorized use of name in advertising that was collateral to a constitutionally protected unauthorized use not actionable).

106. Miller, *supra* note 59, at 659.

107. *Id.*

108. 127 P.2d 577 (Cal. Dist. Ct. App. 1942).

109. *Id.* at 581. In *Kerby*, the defendant movie studio produced a movie whose chief character was a fictional "Marion Kerby." To promote the film, it sent suggestive letters on pink paper to approximately 1,000 Los Angeles males. The plaintiff, Marion Kerby, was a little-known actress, unassociated with the film and unknown to the studio. The court found that "[t]he letter did, in fact, refer to plaintiff in clear and definite fashion, and would reasonably have been so understood by anyone who knew of her existence." *Id.* "The question," the court suggested, "is not so much who was aimed at as who was hit." *Id.* (citations omitted).

to himself and the profits to the defendant.[110] Cases indicate that measures of damages include lost compensation and harm to reputation.[111] Further, neither case holdings nor dicta forecloses mental distress damages, despite the celebrity's overwhelming commercial interest. Instead, dicta contemplates mental distress awards may be proper in some instances.[112] Privacy precedents also support the availability of punitive damages.[113] In addition, injunctive relief is available in appropriate circumstances.[114]

In defining the character of the right, the California Supreme Court agreed with Prosser; the court thought it pointless to debate whether the common law right of publicity was "property."[115] What the court held was that the right is "personal to the artist."[116] The import of this holding appears to be that, unlike the rights created by section 3344, the common law right of publicity can be assigned by the celebrity.[117] The right, however, "must be exercised, if at all, by [the celebrity] during his lifetime"[118] and it expires on the celebrity's death.[119] It does not descend to the celebrity's heirs, as do the rights created by section 990, but instead enters the public domain.[120]

The situation appears to change if the celebrity associates himself with products or services during his life and impresses them with a

110. Eastwood v. Superior Court, 198 Cal. Rptr. 342, 352 n.10 (Ct. App. 1983).

111. Lugosi v. Universal Pictures, 603 P.2d 425, 438-39 (Cal. 1979) (Bird, C.J., dissenting); *accord* Williams v. Weisser, 78 Cal. Rptr. 542 (Ct. App. 1969); Fairfield v. American Photocopy Equip. Co., 291 P.2d 194 (Cal. Dist. Ct. App. 1955).

112. *Lugosi*, 603 P.2d at 439 n.11 (Bird, C.J., dissenting); *accord* Stilson v. Reader's Digest Ass'n, Inc., 104 Cal. Rptr. 581 (Ct. App. 1972); *Fairfield*, 291 P.2d 194.

113. *See, e.g.*, Leavy v. Cooney, 29 Cal. Rptr. 580 (Ct. App. 1963).

114. *Lugosi*, 603 P.2d at 428.

115. *Id.* at 431.

116. *Id.*

117. In so holding, the *Lugosi* court "produced a particularly anomalous result, in that despite the classification of the exploitation right as a personal one, the court acknowledged that the right is assignable, stating that '[a]ssignment of the right . . . by the "owner" thereof is synonymous with its exercise.'" Marla E. Levine, Note, *The Right of Publicity as a Means of Protecting Performers' Style*, 14 LOY. L.A. L. REV., 129, 136 n.36 (1980) (quoting *Lugosi*, 603 P.2d at 431) (alterations in original). *See also* Michael J. McLane, *The Right of Publicity: Dispelling Survivability, Preemption and First Amendment Myths Threatening to Eviscerate a Recognized State Right*, 20 CAL. W. L. REV. 415, 418 (1983). But see Halpern, *supra* note 9, at 1223 n.134, suggesting that in view of the California Supreme Court decisions in *Lugosi* and *Guglielmi*, which stress the personal nature of the right, "a court might hold that a living celebrity does not have a right of publicity that he may assign exclusively to others."

118. *Lugosi*, 603 P.2d at 431.

119. *See* Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 455 (Cal. 1979) (en banc) (holding "the right [of publicity] is not descendible and expires upon the death of the person so protected").

120. *See generally* David Lange, *Recognizing Public Domain*, 44 LAW & CONTEMP. PROBS. (No. 4) 147, 153-56 (1981).

"secondary meaning."[121] Dictum suggests this creates inheritable property.[122] The law of unfair competition, however, not the common law right of publicity, defines the rights of the heirs.[123]

III
Ninth Circuit Interpretation

Federal courts follow applicable state law unless a federal question is at issue.[124] When a state's highest court has not faced an issue, a federal court must decide a diversity case as it believes the state's highest court would have decided it.[125] Since the California Supreme Court has not addressed a right of publicity case since 1979, the Ninth Circuit has developed its own body of "California" law.[126] Although many Ninth Circuit holdings comport with California precedents, recent decisions such as *Waits* and *White*, which emphasize a celebrity's "property" interest in her "identity," go beyond and even contradict California law as interpreted by California courts.[127]

121. *Lugosi*, 603 P.2d at 428.

122. *Id.* at 428-29.

123. *Id.* at 428. *See also* Patrick J. Heneghan & Herbert C. Wamsley, *The Service Mark Alternative to the Right of Publicity*: Estate of Presley v. Russen, 14 PAC. L.J. 181 (1983). Heneghan and Wamsley opined:

> Throughout the [*Lugosi*] opinion the court took judicial notice of the fact that, during his lifetime, Lugosi had never exploited his name or likeness in connection with any business, product, or service. The court postulated that Lugosi could have exploited his right of publicity if he had sold "commercial tie-ups," such as endorsements or licenses to his name, face, or likeness.
>
> The court's extensive discussion about exploitation leads one to conclude that the court would have been compelled to find a *survivable* right of publicity if Lugosi had exploited his right of publicity during his lifetime. This conclusion is erroneous. The exploitation discussion was predicated at the outset of the opinion on an understanding of California unfair competition laws. Stated simply, the *Lugosi* court said that the right of publicity will not survive in any circumstance; however, in the event that the individual's name has achieved a "secondary meaning" in the public's eyes, then the individual's estate or heirs may raise an unfair competition claim.

Id. at 190 n.67 (citations omitted) (quoting *Lugosi*, 603 P.2d at 431 n.5).

124. Erie R.R. v. Tomkins, 304 U.S. 64 (1938).

125. Valley Forge Ins. Co. v. Jefferson, 628 F. Supp. 502, 510 (D. Del. 1986). According to Judge Jerome Frank, the "creator" of the right of publicity, the test should be: "What would be the decision of reasonable intelligent lawyers, sitting as judges of the highest . . . court, and fully conversant with [state] 'jurisprudence?'" Cooper v. American Airlines, 149 F.2d 355, 359 (2d Cir. 1945).

126. Because the Ninth Circuit decisions are only each court's interpretations of California law, their holdings are persuasive, rather than binding precedents on California courts. In addition, because *White* is only a pre-trial ruling, the court's finding that the California common law right of publicity may be present is not a ruling on the merits.

127. This recent approach contrasts with that of the first federal district court to face a California right of publicity action. *See* Strickler v. National Broadcasting Co., 167 F.

A. *Waits v. Frito-Lay, Inc.*[128]

Waits's suit arose from a radio commercial created by Frito-Lay's advertising agency, Tracy-Locke, and broadcast in September and October 1988.[129] The Tracy-Locke jingle introducing Frito-Lay's SalsaRio Doritos mirrored the word play of a Waits song, "Step Right Up."[130]

Although not a superstar, Tom Waits is a singer who has achieved both commercial and critical success in his career.[131] His "raspy, gravelly singing voice" is his distinctive attribute; a fan has described it "as 'like how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades .... Late at night. After not sleeping for three days.'"[132]

Waits has not limited his public exposure to recording and movie contracts or concert appearances.[133] He has sought additional publicity, among other things, by appearing on late night television.[134] Unlike many other entertainers, however, Waits does *not* perform in commercials.[135] His philosophy is that commercials detract from a singer's artistic integrity.[136]

Since Waits's policy on commercials was well known, Tracy-Locke did not try to hire Waits to perform the Doritos commercial.[137] At the same time, Tracy-Locke and Frito-Lay were not content with using someone who could just duplicate the feeling of "Step Right Up."[138] They continued auditioning until they found a musician who had "consciously perfected an imitation of Waits's voice."[139]

Waits was "shocked"[140] when he heard the advertisement and "realized 'immediately that whoever was going to hear this and obvi-

Supp. 68 (S.D. Cal.) (1958). Strickler, who was represented by Melville B. Nimmer, admitted that the right of publicity had "not as yet received recognition in California." *Id.* at 70. Given that admission, the federal district court did "not feel it wishe[d] to blaze the trail to establish in California a cause of action based upon the right of publicity." *Id.* The court did, however, uphold Strickler's complaint for invasion of privacy.

128. Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

129. *Id.* at 1098.

130. *Id.* at 1097.

131. *Id.*

132. *Id.*

133. *Id.*

134. *Id.*

135. *Id.*

136. *Id.*

137. *Id.* at 1097-98.

138. *Id.* at 1097.

139. *Id.*

140. *Id.* at 1098.

ously identify the voice would also identify that [Tom Waits] in fact had agreed to do a commercial for Doritos.'"[141] He filed suit for "voice misappropriation" under California common law.[142] The jury found in his favor and awarded him $100,000 for the fair market value of his services, $200,000 for injury to his peace, happiness, and feelings, and $75,000 for injury to his goodwill, professional standing, and future publicity value. Waits also received $2 million in punitive damages.[143] Frito-Lay appealed to the Ninth Circuit.

Waits did not sue under section 3344 for unauthorized use of his voice. This is probably because in *Midler v. Ford Motor Company*, the Ninth Circuit had held that section 3344 protects only against use of a person's actual voice, not its imitation.[144] The *Midler* court did determine, however, that in California "a well-known singer with a distinctive voice has a property right in that voice."[145] It therefore held: "[W]hen a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a [common law] tort in California."[146] Applying the same rationale to Waits, the court found his claim to be "one for invasion of a personal property right: his right of publicity to control the use of his identity as embodied in his voice."[147]

The court affirmed Waits's judgment, rejecting the defendants' argument that the jury had received inadequate instructions on the elements of "voice misappropriation" articulated in *Midler*—distinctive voice, widely known, deliberately imitated, for commercial purposes.[148] The court reserved ruling on an additional element of the "Midler formula" implicitly added by the trial court—actual confusion—because the validity of the instruction was not at issue on appeal.[149]

The court also rejected the defendants' objections to the damage awards,[150] including the argument that the only damages available in a

141. *Id.* (alteration in original).

142. *Id.* Waits also alleged and prevailed upon a claim for false endorsement under the Lanham Act. *Id.*

143. *Id.* at 1103.

144. Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992).

145. *Waits*, 978 F.2d at 1105 (discussing *Midler*, 849 F.2d at 463).

146. *Midler*, 849 F.2d at 463.

147. *Waits*, 978 F.2d at 1100.

148. *Id.* at 1100-02.

149. *Id.* at 1101 n.3.

150. *Id.* at 1103-06.

right of publicity action are for economic injury.[151] While the court found that the harm to a celebrity often may be solely economic, Waits's "shock, anger, and embarrassment" and his humiliation at being made to look like an "apparent hypocrite" were sufficient to support a mental distress award.[152]

B. *White v. Samsung Electronics America, Inc.*[153]

In contrast with Tom Waits, Vanna White actively markets herself to advertisers to capitalize on her fame from her role as hostess on the Wheel of Fortune game show.[154] Her dispute arose from a series of humorous print advertisements prepared by Samsung's advertising agency, David Deutsch Associates.[155] Each featured a currently popular item or personality and a Samsung electronic product on a twenty-first century set.[156]

The advertisement to which White objected featured a robot attired in a gown, wig, and jewelry that the advertising agency intentionally chose "to resemble White's hair and dress."[157] In addition, "[t]he robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous. The caption of the ad read: 'Longest-running game show. 2012 A.D.'"[158] Those associated with the ad called it the "Vanna White" ad.[159]

Unlike other celebrities who appeared in ads in the series, Samsung neither paid White nor obtained her consent.[160] White, therefore, filed suit for appropriation of her likeness under Civil Code section 3344 and the California common law right of publicity.[161] When the district court granted Samsung summary judgment on each claim, White appealed to the Ninth Circuit.[162]

151. *Id.* at 1103.

152. *Id.*

153. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993).

154. *Id.* at 1396.

155. *Id.*

156. *Id.*

157. *Id.*

158. *Id.*

159. *Id.*

160. *Id.*

161. *Id.* Similar to Waits, White also asserted and was allowed to proceed with a claim under § 43(a) of the Lanham Act. *Id.*

162. *Id.* at 1396-97.

The Ninth Circuit agreed with the district court that the robot was not a likeness of White within the meaning of section 3344.[163] However, it rejected the district court's conclusion that the *Eastwood* decision mandated dismissing White's common law claim.[164] The district court had interpreted *Eastwood* as holding that one could plead violation of the California common law right of publicity only by alleging appropriation of name or likeness.[165] The appellate court contended that name or likeness merely illustrated the means by which appropriations could be effected, rather than limited them.[166] The court supported its determination with the *Midler* court and Prosser's suggestions that appropriation could take place, without use of name or likeness, by impersonation.[167] The court also relied on an earlier Ninth Circuit decision, *Motschenbacher v. R.J. Reynolds Tobacco Co.*,[168] which concluded that California appellate courts would protect an individual's proprietary interest in her own "identity."[169]

163. *Id.* at 1397. The court reserved "deciding for all purposes when a caricature or impressionistic resemblance might become a 'likeness.'" *Id.*

164. *Id.*

165. *Id.*

166. *Id.* According to the *White* court, the *Eastwood* court had "stated that the common law right of publicity cause of action 'may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercial or otherwise; (3) lack of consent; and (4) resulting injury.'" *Id.* (citations omitted). The Ninth Circuit said that the district court's dismissal of White's complaint for failure to satisfy the second prong was inappropriate because the *Eastwood* court had not held that the right of publicity cause of action could *only* be pleaded in that way. *Id.* What the *Eastwood* court actually said was: "A common law cause of action for *appropriation of name and likeness* may be pleaded . . .," which is more supportive of the court's conclusion than its quoted language. Eastwood v. Superior Court, 198 Cal. Rptr. 342, 347 (Ct. App. 1983) (emphasis added).

167. *White*, 971 F.2d at 1398.

168. Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974). *Motschenbacher* was a suit by a professional race car driver for the unauthorized use of a slightly altered photograph of his race car in a Winston cigarette advertisement. Although he was driving the car when photographed, his features were not visible in the picture. The court, however, held this did not preclude finding that the driver was identifiable from the car's distinctive decorations. *Id.* at 827.

Unlike the *White* court, the *Motschenbacher* court reasoned to its holding by careful and extensive review of California precedents. The court's holding rested specifically on the fact that the car's "markings were not only peculiar to the plaintiff's car but they caused some persons to think the car in question was the plaintiff's and to infer that the person driving the car was the plaintiff." *Id.*

Like Prosser, Judge Frank, and the *Lugosi* court, the *Motschenbacher* court was indifferent to whether the interest it found in "identity" was "property." "We only determine that [California courts] would recognize such an interest and protect it." *Id.* at 825-26.

169. *Id. Motschenbacher* also was a cornerstone of the *Midler* and *Waits* decisions. *See* Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993); Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992). One commentator suggests that *Motschenbacher* is analogous to an ac-

Thus, in contrast with *Waits*, the *White* court did not limit itself to considering White's "property" right to any specific attribute.[170] Instead, it framed her right, like the *Motschenbacher* court had, as one to her "identity."[171] In the view of the court, "[t]he law protects the celebrity's sole right to exploit [the value of her identity] whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof."[172]

The core of the court's holding was that California common law gives a celebrity control over more than a "laundry list" of attributes.[173] The court's reasoning was that the more popular the celebrity, the easier it is to evoke the celebrity's identity without using her name, likeness, or voice.[174] It suggested that the means used were at issue only to determine whether appropriation of identity had actually occurred.[175] What established White's identity, in the court's opinion, was the Wheel of Fortune set.[176]

Judge Alarcon dissented, arguing that the court had reached beyond California precedents.[177] He criticized the majority for creating, rather than applying, California law.[178]

Judge Alarcon made two main arguments against "the majority's innovative extension of the [California common law] right of public-

tion for appropriation of likeness. Christopher Pesce, Note, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation*, 65 N.Y.U. L. REV. 782, 801 (1990).

170. *White*, 971 F.2d at 1398.

171. *Id.*

172. *Id.* at 1399.

173. *Id.* at 1398.

174. *Id.* at 1399.

175. *Id.* at 1398. In so holding, *White* moved well beyond *Motschenbacher*, *Midler*, and *Waits* in suggesting the possibility of recovery where the potential for actual confusion or consumer deception did not exist. *See also* Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (taking a similar approach to the use of the phrase "Here's Johnny").

176. *White*, 971 F.2d at 1399. While the majority admitted that considered separately, the robot's physical attributes, its dress, and its stance "say little," it held for White, reasoning:

> Viewed together, they leave little doubt about the celebrity the ad is meant to depict. The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna White dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one.

Id.

177. *Id.* at 1402 (Alarcon, J., dissenting).

178. *Id.* at 1403 (Alarcon, J., dissenting).

ity."[179] The first argument was that the California common law right of publicity differed from section 3344—protecting name, voice, signature, photograph, and likeness—only in the remedies and defenses available.[180] The second argument was that when the legislature amended section 3344 ten years after the *Motschenbacher* decision to add voice and signature, it did not add a cause of action for appropriation of "identity."[181] Judge Alarcon considered this a "clear implication" that the legislature "wished to limit the cause of action to enumerated attributes."[182]

Although Judge Alarcon's thesis would appear to undermine *Midler* and *Motschenbacher*,[183] he distinguished these decisions because in each case "the advertisement affirmatively represented that the person depicted . . . was the plaintiff."[184] He suggested "that where identifying characteristics unique to a plaintiff are the only information as to the identity of the person appearing in an ad, a triable issue of fact has been raised as to whether his or her identity has been appropriated."[185] Judge Alarcon, however, found "nothing unique about Vanna White or the attributes which she claims identify her."[186] Thus, while agreeing that the ad would remind readers of Vanna White, he did not find that it depicted her.[187] In Judge Alarcon's view, the ad depicted a robot playing White's Wheel of Fortune role.[188]

IV
Comparing and Reconciling "California" Law

Even though no California court has imposed liability for unauthorized use of a celebrity attribute other than name, photograph, or likeness, this does not mean that the California common law right of publicity is so constrained.[189] As *Eastwood* and Judge Alarcon sug-

179. *Id.*

180. *Id.* (citing Eastwood v. Superior Court, 198 Cal. Rptr. 342, 346 n.6 (Ct. App. 1983)); *see also supra* note 101. Judge Alarcon also noted that not only had no California court granted recovery for appropriation of "identity," but no California court had found a right of publicity infringement involving other than name or likeness. *Id.* at 1402.

181. *Id.* at 1403.

182. *Id.*

183. This also would be true of *Waits*. However, since *Waits* was decided one week later, it was not addressed.

184. *White*, 971 F.2d at 1404.

185. *Id.*

186. *Id.*

187. *Id.* at 1405.

188. *Id.*

189. *See, e.g.*, Kerby v. Hal Roach Studios, Inc., 127 P.2d 571, 579 (Cal. Dist. Ct. App. 1942) ("New sets of facts are continuously arising to which accepted legal principles must

gest, common law protection should extend at least as far as section 3344 (*i.e.*, to voice and signature).[190] Further, despite *Eastwood's* explanation of the limited differences between section 3344 and common law, cases imply that the scope of the common law right of publicity extends beyond the bare words of section 3344 and their prior common law construction.[191] California precedents do not, however, suggest these rights are property rights.[192]

Using *Waits* and *White* as examples,[193] this section compares the Ninth Circuit's interpretation of the California common law right of publicity with the interpretation suggested by its historical background, California precedents, and policy considerations.

A. Scope

1. Historical Background

The architects of the privacy and publicity doctrines did not imply that a "laundry list of specific means"[194] of appropriation would adequately encompass all the mental and commercial interests they sought to protect. On the contrary, they expected that the law would adapt and grow to meet new situations.[195]

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be applied and the novelty of the factual situation is not an unscalable barrier to the application of the law.").

190. *See supra* notes 101, 180 and accompanying text.

191. *See supra* notes 98-101 and accompanying text.

192. *See supra* notes 115-23 and accompanying text.

193. *Waits* and *White* are good examples because, as the district court in *White* concluded, neither involved a "traditional" California commercial appropriation (*i.e.*, unauthorized use of a celebrity's name, picture, or visual likeness). White v. Samsung Elecs., Am., Inc., 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993). In fact, neither involved the use of any *actual* attribute. Instead, in each, an advertiser pirated "identity" by evoking the celebrity's most recognizable attribute—Waits's voice and White's image.

The cases also offer remarkable contrast. The advertisers employed means of evocation at opposite ends of a spectrum. The appropriation in *Waits* was direct. Although Frito-Lay used someone else's voice in the commercial, the voice used was indistinguishable from Waits's voice. The appropriation in *White*, on the other hand, was more remote. Samsung combined otherwise indistinguishable elements—hair and attire—in an identifiable context (the Wheel of Fortune set) to create her overall image.

The two cases also differ in the interests impacted. The appropriation in *White* infringed solely on White's commercial interest, while the gist of Waits's injury was at least as much mental as commercial.

194. *Id.* at 1398.

195. *See, e.g.*, Warren & Brandeis, *supra* note 23. "That the individual shall have full protection in person and in property is a principle as old as the common law; but it has been found necessary from time to time to define anew the exact nature and extent of such protection." *Id.* at 193. "Indeed, the elasticity of our law, its adaptability to new conditions, the capacity for growth, which has enabled it to meet the wants of an ever changing society and to apply immediate relief for every recognized wrong, have been its greatest boast . . . ." *Id.* at 213 n.1.

However, they balanced the desire for adaptability with the understanding that privacy and publicity rights must have limits.[196] This was particularly true where celebrities or other public figures were concerned.[197] Prosser, as well as Warren and Brandeis, used identifiability of the representation as one of the significant criteria to distinguish what was actionable from what was not.[198]

Use of identifiability as a criterion strongly supports a finding for Waits.[199] In *Waits*, the jury found the imitation was good enough to convince listeners that Waits sang the commercial.[200] Thus, imitating Waits's voice was nothing less than impersonating him. Prosser himself suggested impersonation would be actionable, without using name or likeness, if identifiability existed.[201]

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196. *See, e.g.*, Prosser, *supra* note 29, at 422-23.

> It is evident . . . that, by the use of a single word supplied by Warren and Brandeis, the courts have created an independent basis of liability . . . that . . . has been expanded . . . without any plan, without much realization of what is happening or its significance, and without any consideration of its dangers. . . . [I]t is high time we realize what we are doing, and give some consideration to the question of where, if anywhere, we are to call a halt.

In dissenting from the Ninth Circuit's order rejecting the suggestion for rehearing *White* en banc, Judge Kozinski agreed:

> Something very dangerous is going on here [in *White*]. Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors. But reducing too much to private property can be bad medicine. Private land, for instance, is far more useful if separated from other private land by public streets, roads and highways. Public parks, utility rights-of-way and sewers reduce the amount of land in private hands, but vastly enhance the value of the property that remains.
>
> So too it is with intellectual property. Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, and each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.

White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting) (citing Wendy J. Gordon, *A Property Right in Self Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1556-57 (1993)).

197. *See* Nimmer, *supra* note 2, at 216-17; Prosser, *supra* note 29, at 415; Warren & Brandeis, *supra* note 23, at 216.

198. *See, e.g.*, Prosser, *supra* note 29, at 404-05 ("[T]here is no liability for the publication of a picture of [the plaintiff's] hand, leg and foot . . . with nothing to indicate whose they are."); Warren & Brandeis, *supra* note 23, at 206 n.1 ("It is clear that a thing must be capable of identification in order to be the subject of exclusive ownership.").

199. As the *Midler* court noted: "A voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested." Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992).

200. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1101 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

201. Prosser, *supra* note 29, at 403.

White's argument on identifiability is less persuasive. As the *White* majority admitted, the wigged and gowned robot, viewed separately, could evoke many women other than Vanna White.[202] Only the Wheel of Fortune game board supplied the "context or addition of some other element" that Prosser considered necessary to create liability.[203]

2. California Precedents

Existing California law similarly suggests holding for *Waits* and dismissing *White*. For example, in testing Waits's claim, section 3344's protection of "voice" and "likeness" could be read together to include vocal impersonations.[204] The *Waits* court did not consider this alternative because in *Midler* the Ninth Circuit found section 3344 protected only a person's actual voice.[205] The *Midler* court refused to expand upon the California courts' interpretation of "likeness" as a visual image.[206]

While facially correct, this construction ignores the fact that no California court has construed "likeness" since the legislature included voice in section 3344[207] and that California appellate courts have held unauthorized use of "like" names to be actionable. For example, in *Kerby v. Hal Roach Studios, Inc.*, the court held that liability attached if someone reading a name could reasonably understand it to be the plaintiff's.[208] In a related context, a California appellate court denied actor Eugene Weingand's petition to change his name to "Peter Lorie" because it viewed adopting the "like" name as an attempt to "cash in" on actor Peter Lorre's reputation.[209]

In *Waits*, where intent to evoke the singer's voice was clear, the argument for imposing liability is even more forceful. The *Waits* jury was not instructed it could find liability merely if the voice in the Frito-Lay commercial was *like* or could *reasonably be understood* to

202. *See supra* note 176.

203. Prosser, *supra* note 29, at 403-04.

204. *See* Wohl, *supra* note 53, at 455. Construed this way the appropriation also would be actionable under § 3344. Of course in reading "likeness" together with voice, prior construction of "likeness" as a fairly exacting replication could not be ignored. This should be satisfied by the facts of *Waits*.

205. Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992).

206. *Id.*

207. Nurmi v. Peterson, 10 U.S.P.Q.2d 1775, 1777 (C.D. Cal. 1989).

208. 127 P.2d 577, 581 (Cal. Dist. Ct. App. 1942). Section 3344 adopts a similar type of "reasonable" determination as to whether use of a person's photograph is actionable. *See supra* note 64.

209. *See In re* Weingand, 41 Cal. Rptr. 778 (Ct. App. 1964).

be Tom Waits's; the jury instruction required that "people who were familiar with plaintiff's voice who heard the commercial believed plaintiff performed it."[210]

In contrast, no one looking at the Samsung robot could believe it was Vanna White. The robot's "features," excepting the wig and the gown, were mechanical and did not bear the exacting resemblance required to support a "likeness" action.[211] Dismissal also would be consistent with *Kerby*, since it is unlikely a juror could reasonably understand the robot to actually be *any person*, much less White.[212] The actual confusion that existed in *Waits* is not even an issue in *White*.[213]

To hold for White under California precedents requires equating the interest the court found White had in her "identity" with the interest in "personality"[214] that *Lugosi* suggested merits legal protection. When personality is construed according to one of its dictionary meanings, "distinctive character," California case law suggests that appropriation may be actionable.[215] For example, in 1928, a California appellate court upheld an injunction restraining Charles Amador from using the name "Charles Alplin" and attiring himself like Charlie

210. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1101 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

211. *See supra* notes 65, 95. White's claim might have been more supportable if she could have sued for appropriation of her "image." However, when amending § 3344 in 1984, the legislature specifically determined not to extend its protection to "image," reinforcing the propriety of the dismissal. *See supra* note 66. As Judge Alarcon pointed out, the legislature also did not extend § 3344's protection to "identity." *See supra* text accompanying note 181.

212. *Kerby*, 127 P.2d at 581. Analogy to § 3344's treatment of photographs also applies here. ("A person shall be deemed to be readily identifiable from a photograph when one . . . can *reasonably determine* that the person *depicted* . . . is the *same person*.") § 3344(b)(1) (emphasis added). As Judge Alarcon suggested, what is *depicted* is a robot playing Vanna White's role.

213. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1400 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993) (no evidence of actual confusion presented).

214. *Compare* the definition of "identity":

> 1. state or fact of remaining the same one, as under varying conditions. 2. the condition of being oneself or itself, and not another. . . . 3. condition or character as to who a person or what a thing is . . . . 4. state or fact of being the same one. . . . 5. exact likeness in nature or qualities.

with the definition of "personality":

> 1. *distinctive or notable personal character* . . . . 2. a person as an embodiment of an assemblage of qualities. 3. *Psych.* a. all the constitutional, mental, emotional, social etc. characteristics of an individual. b. an organized pattern of all the characteristics of an individual. . . . 5. *the essential character of a person as distinguished from a thing.*

THE AMERICAN COLLEGE DICTIONARY 599, 904 (1966) (emphasis added).

215. *See supra* notes 95, 98.

Chaplin's "Little Tramp" in motion pictures.[216] However, the *Chaplin v. Amador* court affirmed the injunction only because the defendant tried to deceive the public into believing that Chaplin was the actual star and specifically did "not depend on [Chaplin's] exclusive right to the use of the role, garb, and mannerisms [of the Little Tramp]."[217]

Blond hair, big jewelry, and a long gown are not "personality" comparable to Chaplin's character.[218] If they were, any later Wheel of Fortune hostess would violate White's right of publicity merely by being blond and wearing the same attire.[219] When combined with the absence of consumer deception, California precedents suggest that Samsung's "appropriation" should not be actionable.

3. Policy

Policy considerations support comparable results. From the celebrity's perspective, the goal of the right of publicity—its policy rationale—is to prevent unauthorized use of the celebrity's attributes and, failing that, to obtain compensation for such use.[220] Assuring celebrity compensation, however, is a secondary consideration in recognizing a right of publicity.[221]

The primary state interest, as in patent and copyright law, is encouraging the individual to expend the effort necessary to create something of value for the public.[222] In the celebrity context, this is

216. Chaplin v. Amador, 269 P. 544 (Cal. Dist. Ct. App. 1928).

217. *Id.* at 546. The court found that Chaplin had created a peculiar type of character on the motion picture screen:

> In this character, Chaplin has generally worn a kind of attire *peculiar and individual to himself*, consisting of a particular kind or type of mustache, old and threadbare hat, clothes, and shoes, a decrepit derby, ill-fitting vest, tight fitting coat, and trousers and shoes much too large for him, and with this attire, a flexible cane usually carried, swung, and bent as he performs his part. This character, and the manner of dress, has been used and portrayed by Charles Chaplin for so long, and with such artistry, that he has become well known all over the world in this character to such an extent that a display of his picture with the word "Charlie," or even with no name at all, has come to mean the plaintiff.

Id. at 545. *But see* West v. Lind, 9 Cal. Rptr. 288 (Ct. App. 1960) (although West developed the role of "Diamond Lil," defendant's use of the name did not create public deception).

218. California precedent suggests a strong showing is necessary to assert an exclusive right to a character. *See supra* note 98.

219. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1405 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993) (Alarcon, J., dissenting) ("To say that Vanna White may bring an action when another blond female performer . . . appears on such a set as a hostess will, I am sure, be a surprise to the owners of the show.").

220. Nimmer, *supra* note 2, at 204.

221. Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576-77 (1977).

222. *Id.* at 574, 576.

typically some form of entertainment.[223] The right of publicity also serves a broader social purpose in preventing unjust enrichment of the "thief" of the celebrity's "goodwill."[224] In addition, where an appropriation suggests the celebrity's use or endorsement of a product, the state has an interest in preventing consumer deception.[225]

In *Waits*, each of these policies argues for finding a violation of Waits's right of publicity. Waits invested his time, energy, and skill developing a distinctive and distinguishable vocal performance. Frito-Lay's "conversion" of the sound of his voice was to its benefit and at Waits's expense. Further, because the imitation was indistinguishable from his actual voice, it created the false impression that Tom Waits endorsed SalsaRio Doritos.

In contrast, allowing White to proceed supports none of these policies. It rewards White merely for being famous,[226] not for her creative efforts.[227] Moreover, Samsung's enrichment must be at White's expense to be "unjust."[228] The robot, however, was only identifiable from the Wheel of Fortune set. Thus, any enrichment was at the ex-

223. *Id.* at 576.

224. *Id.*

225. Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 839 (6th Cir. 1983) (Kennedy, J., dissenting).

226. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1405 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993) (Alarcon, J., dissenting).

227. As the *White* majority implicitly suggests, awarding White damages would compensate her only for her "dumb luck" at being selected for the Wheel of Fortune hostess role. *Id.* at 1399. The attire worn by the robot is not distinctive, distinguishable, or White's creation. Their combination takes no innovation; as the *White* majority itself conceded, many women dress exactly like this. The Wheel of Fortune set, also not White's creation, is what identifies her.

A recently filed case suggests that policy considerations might not even be served by making actionable the unauthorized use of traditionally protected attributes, such as name and likeness, where the person's celebrity status, though the result of her own "creative energy," is achieved by objectionable or illegal means. Bianchi v. Yronwode, No. CS-92-312-FVS (E.D. Wash. filed Dec. 15, 1992). In the complaint, Kenneth Bianchi (also known as the "Hillside Strangler") seeks a share of the profits from the unauthorized use of his name and caricature on True Crime Trading Cards. *Hillside Stranger Sues Over Crime Cards, He Says Sonoma Firm Owes Him Part of Profits Because He Is One of the Featured Killers*, S.F. CHRON., Dec. 16, 1992, *available in* DIALOG. According to Bianchi, the trading card maker "'has exploited' his name and violated his rights. In addition, he says the public may become 'confused' as to who originated the card." *Id.* In Bianchi's view, in order to assert a right of publicity action, "[a]ll a person must do is reach a level of fame." *Murderer's Row*, CAL. LAW., Mar. 1993, at 20. "His persona has a drawing power, the value of which gives a public figure the power to sell it." *Id.*

228. *Carson*, 698 F.2d at 839 (Kennedy, J., dissenting) ("[B]ecause a celebrity . . . is himself enriched by . . . things associated with him in which he has made no personal investment of time, money or effort, another user of such a . . . thing may be enriched somewhat by such use, but this enrichment is not at [the celebrity's] expense." As such, "[t]he policies behind the right of publicity are not furthered by [imposing liability for their unauthorized use].").

pense of the show's owners, not White's.[229] Finally, the ad did not deceive the public as to White's participation[230] or endorsement. Samsung's use of the robot may, in fact, suggest the contrary conclusion—that she did not appear because she did *not* endorse the product.[231]

B. Elements/Standing

California courts have never segregated the right of publicity into "species" as the Ninth Circuit did when it created "voice misappropriation" in *Midler*.[232] However, some elements of the cause of action articulated in *Midler* and *Waits*—"distinctive voice" and "widely known"—do reflect the substance of California common law principles.[233] "Widely known," for example, suggests the standing necessary to bring a California common law right of publicity action: only someone whose public recognition makes her commercially exploitable can sue.[234] Similarly, the combination of "widely known" and "distinctive voice" implies that the "owner" of the voice must be reasonably identifiable before liability can be imposed.[235]

In contrast, "knowing" or "deliberate" use is not a necessary element of a common law cause of action as *Midler* and *Waits* require.[236] In fact, the availability of mistake and inadvertence as defenses are among the clearly recognized distinctions between a section 3344 and a common law claim.[237]

C. Property vs. Personal Right

The Ninth Circuit's most significant misreading of California law was its determination that a celebrity has a property interest in her identity. This "property" classification originated with the *Midler* court's reasoning: "The companion statute [to section 3344 (section

229. *White*, 971 F.2d at 1405 (Alarcon, J., dissenting).

230. *Id.* at 1400.

231. *But see id.* (because White is well known, likelihood of confusion over her endorsement may be increased).

232. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993) ("The Midler tort is a species of violation of the 'right of publicity.'").

233. But see *supra* notes 104, 166, suggesting the elements of a right of publicity cause of action in the view of California courts.

234. *See supra* note 91 and accompanying text. Section 990's definition of "deceased personality" is also in accord.

235. *See supra* notes 109, 208 and accompanying text.

236. *See supra* note 106 and accompanying text.

237. *See supra* notes 101, 180 and accompanying text. In reality, however, an imitation or impersonation by definition incorporates conscious exertion. As such, it may be nonessential or even redundant to impose intent as a condition of liability to the type of common law right of publicity claim asserted by Waits.

990)] protecting the use of a *deceased* person's name, voice, signature, photograph or likeness states that the rights it recognizes are 'property rights.' By analogy the common law rights are also property rights. Appropriation of such common law rights is a tort in California."[238]

Although Prosser, among others, was indifferent to the "property" label,[239] it is not at all "clear that, in California at least, a well-known personality with a distinctive voice has a property right in that voice," as *Waits* suggests.[240] In fact, section 3344 and case law indicate the opposite may be true.[241] Further, when given the opportunity to alter *Lugosi's* holding that the right of publicity is "personal to the artist,"[242] the legislature specifically rejected "property" characterization, at least during the celebrity's life.[243]

Since the *Waits* court could have reached the same outcome by construing "voice" and "likeness" less literally, "property" classification should not have been necessary to impose liability.[244] That the Ninth Circuit resorted to analogizing from section 990, however, shows how confusing the legislature's asymmetrical approach to the treatment of living and deceased personalities' rights can be.[245] In recent Ninth Circuit cases, the result of this confusion may be "bad law."[246]

238. Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992) (emphasis added) (citations omitted).

239. *See supra* notes 35, 115 and accompanying text.

240. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1105 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

241. *See supra* notes 77-79, 115-23 and accompanying text.

242. Lugosi v. Universal Pictures, 603 P.2d 425, 431 (Cal. 1979) (en banc).

243. *See supra* notes 80, 84.

244. *See supra* notes 204-10 and accompanying text.

245. *See supra* notes 78, 84 and accompanying text.

246. *See supra* note 9.

Judge Kozinski agrees:

> The panel's opinion [in *White*] is a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority's opinion, it's now a tort for advertisers to remind the public of a celebrity. Not to use a celebrity's name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity's image in the public's mind .... It's bad law, and it deserves a long, hard second look.

White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting).

D. Mental vs. Commercial Interest

On the other hand, the Ninth Circuit may have proved what was considered "bad law" was really "good law."[247] Although the *Waits* court generally took a property-based approach emphasizing the independent commercial interest of "publicity,"[248] it reverted to familiar California authorities, which emphasize a person's *dual* commercial and mental interests, when reviewing the jury's damage awards.[249] More than one-half of the compensatory damage award affirmed by the court was for injury to Waits' peace, happiness, and feelings[250]—the mental interest protected by the right "to be let alone."[251]

Waits therefore shows that the California scheme can be a strength[252] rather than a weakness in recognizing that celebrities retain the mental interest in their "personalities."

247. Advocates of publicity as a property right have often criticized the dual interests—mental and commercial—encompassed by Prosser's tort of appropriation that forms the foundation of California law. Some, in fact, have suggested that the duality of protected interests is the reason publicity doctrine has not developed cohesively. *See, e.g.*, Lugosi v. Universal Pictures, Inc., 603 P.2d 425, 437-39 (Cal. 1979) (Bird, C.J., dissenting); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 834 (6th Cir. 1983); Halpern, *supra* note 9, at 1209-11.

248. *See supra* notes 38-51 and accompanying text.

249. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1103-06 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993); *see also supra* notes 72-76, 110-14 and accompanying text.

250. The phrasing of Waits's damage award is reminiscent of the first California case implicitly to recognize the right of privacy, which rested its holding on the California constitutional right to "pursue and obtain happiness." Melvin v. Reid, 297 P. 91, 93 (Cal. Dist. Ct. App. 1931). *See supra* note 56.

251. *See supra* notes 27-28 and accompanying text.

252. Even Professor McCarthy suggests that this is the preferred approach if courts can understand it:

> Prosser tried to keep commercial injury . . . within the framework of his famous "four torts" of privacy.
>
> But Prosser's effort failed, perhaps because others . . . strongly pushed the concept of the right of privacy as a unified tort . . . tied together by the common denominator of an affront to human dignity. In such a human dignity-centered right . . . [c]ommercial injury only found its place outside of the "privacy" framework altogether. But once outside of the "privacy" category, no one would give it serious consideration until it received a name. And it was Judge Jerome Frank who finally saw the need and dubbed it the "Right of Publicity."
>
> Undoubtedly, the law today would be more coherent and neat if it had developed such that courts would recognize a *sui generis* legal right labeled something like a "right of identity" with damages measured by *both* mental distress and commercial loss. If the law had such a separately entitled category, things would be considerably easier to sort out compared to our present world of "separate" rights of privacy by appropriation and a Right of Publicity.

MCCARTHY, *supra* note 37, at § 1.11[C] (citations omitted).

V
Creating Clarity in California Law

If California publicity law is somewhat uncertain, misreading the law as the *Waits* and *White* courts did can only add to that uncertainty.[253] In addition, the differing interpretations of California law between the California appellate courts and the Ninth Circuit create an opportunity for forum shopping.[254] To reduce confusion and forum shopping, California must define the scope of the right of publicity more precisely and reconsider its inconsistent treatment of personal and property rights. Although the California statute does not parallel common law as closely as Judge Alarcon suggests,[255] it could be amended to help accomplish this end.[256] Statutory change is necessary to eliminate disparate treatment between living and deceased celebrities and to codify important California precedents into the statute's "plain meaning." Creating this clarity does not require a complete statutory overhaul, however, as the means to eliminate the uncertainty exist in the statutory scheme.

A. Property/Personal Rights

The rights created by section 3344 must be made more symmetrical with those of section 990.[257] As the Ninth Circuit implied by analogizing "property" rights between the two sections,[258] it is anomalous to have a right become statutorily "transformed" at death from unenforceable to enforceable in the hands of a third party.[259] Assignees of celebrity attributes should have standing to sue under both section 3344 and common law.

One suggestion is for the legislature to create a mechanism within section 3344 enabling assignees to register their rights to use statutorily protected attributes, a right the assignees and heirs of deceased

253. *See* Wohl, *supra* note 53, at 455-58 (using Ninth Circuit decisions to illustrate California's "expansive view" of the right of publicity).

254. Since Ninth Circuit treatment is more favorable to plaintiffs, incentive exists to elect the federal forum, further reducing the ability of California courts to define California common law.

255. *See supra* note 180 and accompanying text.

256. *See, e.g.*, Katherine L. Blanck, Comment, *Restricting the Use of "Sound-Alikes" in Commercial Speech by Amending the Right of Publicity Statute in California*, 26 SAN DIEGO L. REV. 911 (1989) (arguing for amendment of California Civil Code § 3344 to include vocal imitations).

257. *See supra* notes 77-79, 84-90 and accompanying text.

258. Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513, 1514 (1992).

259. *See supra* notes 77-79, 84-86 and accompanying text.

personalities now have under section 990.[260] This can be done without significant administrative burdens by making the registration alternative available only to assignees of rights. Non-celebrities and celebrities who do not assign their rights would continue to enjoy the current protection of section 3344.[261]

This registration mechanism makes sense for several reasons. Since only those whose attributes have commercial value are likely to make assignments, celebrities will receive the special considerations that courts and commentators argue they deserve. Whether or not one calls the assigned attribute "property,"[262] registration could create the third-party enforceability that initially spawned the property versus personal right debate.[263] In addition, with the exception of the knowing use requirement while the celebrity lives,[264] the assignee's rights would be the same before and after the celebrity's death. Requiring the assignee to register also would place the administrative burden, like section 990, on the person or entity seeking section 3344's protection.[265]

Furthermore, to the extent that the right of publicity serves the same social purposes as copyright and patent law, registration appears a particularly apt solution.[266] The assignment creates a document (the contract between the celebrity and the assignee) amenable for use to describe the rights claimed,[267] similar to a copyright application.

Finally, registration would provide an important notice function. It would not only stake a particularized claim to an attribute, but also

260. *See supra* text accompanying notes 89-90.

261. *But see*, David C. Byers, *Copyright to Life: Towards Copyright Protection for Name and Likeness*, CAL. ST. B.J., Feb. 1981, at 52, 54 (suggesting registration of celebrity attributes under copyright law model as a prerequisite to any judicial enforcement).

262. Felcher and Rubin suggest that designation of publicity rights as property could have "wide-ranging" effect: "It could imply that the right, like other property rights, is not only transferable [and devisable], but that it is taxable; that it can serve as a capital asset, or as security for a loan; and that it should be taken into account in a divorce settlement." Felcher & Rubin, *supra* note 6, at 1593.

263. *See supra* notes 47-50 and accompanying text.

264. The knowing use requirement of § 3344 could be eliminated as well, making §§ 3344 and 990 identical in this respect. This also would make § 3344 more parallel with the common law rights of privacy and publicity to which inadvertence or mistake are not defenses. *But see supra* note 70.

265. It would be similar to the requirement that a corporation register as a foreign corporation in a particular jurisdiction prior to instituting suit in that jurisdiction.

266. *See* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977) (noting that the purpose of the right of publicity is closely related to that of copyright law).

267. The rights, of course, would have to be within the scope of § 3344's protection.

would let the public know from whom consent to its use must be obtained.[268]

B. Scope/Elements/Standing

As the majority and dissenting opinions in *White* show, courts and commentators differ materially on how far the right of publicity should extend. Even without considering the extensive First Amendment concerns, the line between what should and should not be actionable is difficult to draw.[269]

No one could seriously dispute that Samsung received value by evoking Vanna White's "identity" in its advertisement.[270] This economic reality is what drives many, like the *White* majority, to contend that the right of publicity should protect any means an advertiser uses to evoke a particular celebrity.[271] Others, however, suggest that this approach does not distinguish between those aspects of a celebrity's personality that are worthy of protection and those that are not.[272]

California common law precedents—which focus on uniqueness, reasonable identifiability, and likelihood of confusion[273]—reflect this latter, better-reasoned approach. This approach also comports with the policies that underlie the right of publicity: stimulating creative efforts and protecting the public from deception. Further, where the claim results from use of something merely associated with a celebrity, the claim of unjust enrichment becomes too weak to justify liability.[274]

268. This could create an additional benefit to assignees dealing with celebrities like the *Haelan* ballplayer who was generous in granting his "exclusive" rights. *See supra* note 46.

269. *See* Pesce, *supra* note 169, at 799 ("The resolution . . . depends on how much imitation, evocation or invocation is considered too much.").

270. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1405 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993) (Alarcon, J., dissenting).

271. Halpern, *supra* note 9, at 1242-46. This group focuses on what the appropriator gets, not on what the celebrity gives up, and does not demand that the use be deceptive. *But see* White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting) ("Intellectual property rights aren't like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant. They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation.") (citation omitted).

272. Commentators adopting this posture require that the attribute have an independent commercial value. *See* Felcher & Rubin, *supra* note 6, at 1614-15. They also suggest that the advertiser's receipt of value come at the celebrity's expense. *See* Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 839 (6th Cir. 1983) (Kennedy, J., dissenting); Pesce, *supra* note 169, at 803.

273. *See, e.g.*, Kerby v. Hal Roach Studios, Inc., 127 P.2d 577 (Cal. Dist. Ct. App. 1942); Chaplin v. Amador, 269 P. 544 (Cal. Dist. Ct. App. 1928); *see also* Pesce, *supra* note 169, at 824 (courts should incorporate Lanham Act's likelihood of confusion requirement into the right of publicity).

274. Pesce, *supra* note 169, at 802. One commentator suggests:

The legislature should amend section 3344 to reflect this compromise position.[275] This does not require creating species of causes of action as the Ninth Circuit did with "voice misappropriation."[276] It does require recognition that a person has an interest in her "identity" or "personality" in the sense that Prosser and Warren and Brandeis used these words—something that is distinctive, unique and part of her.

The legislature should make clear that imitations or impersonations of protected attributes are actionable under section 3344, perhaps by defining "likeness." A cause of action should only accrue, however, if the imitation/impersonation causes actual confusion or is reasonably likely to cause actual confusion about a person's participation.

The legislature also should specifically extend section 3344 to protect, to the very limited extent common law appears to, distinctive characters, such as Chaplin's "Little Tramp."[277] Imitators of such distinctive characters, however, should be subject to liability only when imitators of other protected attributes would be—where actual or reasonably likely confusion exists. In addition, protection should extend only to characters developed through the effort and creative energies of the person seeking recovery.[278]

Finally, the legislature should extend section 3344's protection to a very limited class of things associated with a celebrity. This would potentially encompass appropriations of associated aspects that are more identifiable in the particular circumstances than the celebrity's

> [T]he right of publicity should not be extended to protect things merely associated with a celebrity, regardless of the direct correlation between their commercial value and that celebrity's success. One of the assumptions underlying the right of publicity is that the appropriated characteristic is the product of "[the celebrity's] own talents and energy [and] the end result of much time, effort and expense." Only then is the enrichment of the appropriator unjust because, in such a case, he could be said to be enjoying the fruits of another's labor. But alleged "appropriators" are also entrepreneurs who expend time and talent of their own to create and market valued commodities. When the right of publicity protects phrases and objects merely associated with celebrities, it is not always clear that the interests of a celebrity—or worse, that celebrity's undistinguished descendant—should outweigh the interests of a commercial entity or entrepreneur.

Id. at 802-03 (alterations in original) (citations omitted) (quoting Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 575 (1977)).

275. Comparable amendments to § 990 would be appropriate as well.

276. *See supra* note 232.

277. *See supra* notes 215-17 and accompanying text; *see also supra* notes 95, 98.

278. Or the person's assignor. A strong showing should be necessary to restrict an infringing performance. *See supra* note 98.

name or photograph, for example, might be.[279] For liability to attach, the associated aspect should have to be unique, substantially of the claimant's creation,[280] and create actual or reasonably likely confusion.[281]

Amending section 3344 in these ways will send a strong message to the federal courts that the California right of publicity is neither as narrow as the district court in *White* suggested[282] nor as broad as the Ninth Circuit held in that case.[283]

VI
Conclusion

Development of the California common law right of publicity has been confounded by the lack of cases being filed in California courts. As a result, the Ninth Circuit has created its own body of California right of publicity law. Some Ninth Circuit holdings contradict California authority. Others have expanded the scope of the California right of publicity beyond that warranted by its historical background, California precedents, and policy considerations. California legislative action is necessary if California is to control the determination of the important rights of its celebrities.

279. *See, e.g.*, Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 827 (9th Cir. 1974) (professional race car driver's car was instantly recognizable, whereas a picture of his face would not have been recognizable).

280. Or that of the claimant's assignor.

281. "Protecting phrases and other things merely associated with an individual provides virtually no notice to the public at all of what is claimed to be protected . . . . [T]he public is left to act at their peril. The result is a chilling effect on commercial innovation and opportunity." Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 840 (6th Cir. 1983) (Kennedy, J., dissenting).

282. *See supra* text accompanying note 165.

283. *See supra* text accompanying notes 170-72.